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10/682,266	10/09/2003	Donald E. Burg	104-146	8275

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Colonial Bank Building
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EXAMINER

GUTMAN, HILARY L

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/682,266

Applicant(s)

BURG, DONALD E.

Examiner

Hilary Gutman

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,16,17,20,23-27 and 30-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,16,17,20,23-27 and 30-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species A, Subspecies C in the reply filed on 10/7/04 is acknowledged.
2. No claims are withdrawn from further consideration pursuant to 37 CFR 1.142(b).

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The clause regarding "willful false statements ..." required by 37 CFR 1.68 has been omitted.

It appears that a page of the specification is missing. The first page ends with "and further that these statements"... It appears something more should follow. Additionally, there is no signature from the inventor.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the brake of claims 1, 26, and 27 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

On page 3, line 15, "twenty-five" should apparently be "thirty". Also on line 18, "thirty-five" should be "forty-five". Appropriate correction is required.

Claim Objections

6. Claim 25 is objected to because of the following informalities: on line 1, "claim 21" should apparently be "claim 24" since claim 21 was canceled.

Appropriate correction is required.

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 26 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 17.
9. Claims 27 and 37-42 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1, 4, 6, 7, and 23-25, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 30, 43-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 30 and the recitation “means to adjust”, it should be noted that if one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 16, 17, 20, 23, 26-27, 30, 34, 40, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Pettey.

Pettey (6,565,145) discloses in an improved first aerostabilizer for vehicles that is capable of changing to a more vertical position when the vehicle is decelerated to thereby add an aerodynamic braking force that aids in slowing down the vehicle, the improvement comprising: a motor 66 in communication with the first aerostabilizer 12 wherein the motor provides an actuation force when a brake of the vehicle is applied, the actuation force causes a movement of the first aerostabilizer about a pivot resulting in a raising of one end of the first aerostabilizer higher than another end (Figures 1 and 3) of the first aerostabilizer such that the first aerostabilizer is at a more vertical than horizontal orientation to thereby provide the aerodynamic braking force.

With regard to claim 16, the motor is powered by electricity.

With regard to claims 17 and 26, the motor is apparently an electric linear actuator motor.

With regard to claim 20, the motor is disposed, at least in part, internal to the first aerostabilizer (Figures 6-7).

With regard to claims 23, 34, 40, and 46, the motor is disposed, at least partially, internal to a first stanchion 40 and wherein the first stanchion is disposed between the first aerostabilizer and an attachment means (Figures 6-7) on the vehicle.

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For claim 30, Pettey discloses in an improved first aerostabilizer 12 for vehicles that is capable of changing to a more vertical position (Figures 1 and 3), the improvement comprising: an electric motor 66 in communication with the first aerostabilizer 12 wherein the motor provides an actuation force when electric power is supplied to the electric motor to thereby provide means to adjust the orientation of the first aerostabilizer about a pivot resulting in a raising of one end of the first aerostabilizer higher than another end of the first aerostabilizer such that the first aerostabilizer is at a more vertical than horizontal orientation.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 4-7, 32-33, 37-39, and 43-45 are rejected under 35 U.S.C. 103(a) as being obvious over Pettey as applied to claims 1, 26, 27, 30 above, and further in view of Brown et al.

The applied reference (Brown et al.) has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective

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U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Petty discloses the pivot being disposed proximate a forward end of the first aerostabilizer (Figure 8).

Petty lacks the pivot being disposed proximal an average fore to aft mid-point of the first aerostabilizer or within 15, 30, or 45% of the mid-point.

Brown et al. (6,805,399) teach a first aerostabilizer wherein a weight provides an actuation force when a brake of the vehicle is applied, the actuation force causes a movement of the first aerostabilizer about a pivot resulting in a raising of one end of the first aerostabilizer higher than another end (Figures 2, 4, 6, and 9) of the first aerostabilizer such that the first aerostabilizer is at a more vertical than horizontal orientation to thereby provide the aerodynamic braking force. Brown et al. teach the pivot being disposed proximal an average fore to aft mid-point of the first aerostabilizer in one embodiment and being disposed within 15%, 30%, or 45% of a mid-point of an average fore to aft length of the first aerostabilizer in alternate embodiments.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the pivot of the aerostabilizer of Petty to be disposed either

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proximate an average fore to aft mid-point of the first aerostabilizer or alternately to be disposed within 15%, 30%, or 45% of a mid-point of an average fore to aft length of the first aerostabilizer as taught by Brown et al. in order to minimize the forces required to move the aerostabilizer.

16. Claims 24-25, 35-36, 41-42, and 47 are rejected under 35 U.S.C. 103(a) as being obvious over Pettey as applied to claims 23, 34, 40, and 46 above, and further in view of Brown et al.

The applied reference (Brown et al.) has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

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With regard to claims 24, 35, 41, and 47, Pettey discloses a second stanchion 40 being further provided with the first and second stanchions 40, 40 in communication by the first aerostabilizer. A brake light 18 is provided in proximity to the aerostabilizer.

Pettey lacks a connecting structure for communication of the first and second stanchions wherein a vehicle stoplight is mounted to the connecting structure.

Brown et al. (6,805,399) teach a first aerostabilizer wherein a weight provides an actuation force when a brake of the vehicle is applied, the actuation force causes a movement of the first aerostabilizer about a pivot resulting in a raising of one end of the first aerostabilizer higher than another end (Figures 2, 4, 6, and 9) of the first aerostabilizer such that the first aerostabilizer is at a more vertical than horizontal orientation to thereby provide the aerodynamic braking force. Additionally, the weight is disposed, at least partially, internal to a first stanchion and wherein the first stanchion is disposed between the first aerostabilizer and an attachment means on the vehicle. A second stanchion is also taught as well as a connecting structure to allow for communication of the first and second stanchions. The connecting structure (Figs 1-2) is disposed, at least primarily, below the first aerostabilizer and above the attachment means on the vehicle. A vehicle stoplight is mounted to the connecting structure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a connecting structure with a stoplight as taught by Brown et al. upon the aerostabilizer of Pettey in order to provide the aerostabilizer with more structural rigidity and to provide additional warning by means of brake lights when the vehicle decelerates.

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Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 703-305-0496.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

19. **Any response to this action should be mailed to:**

Assistant Commissioner for Patents
Washington, D.C. 20231

or faxed to:

(703) 872-9326, (for formal communications intended for entry)

or:

(703) 746-3515, (for informal or draft communications, please clearly label
"PROPOSED" or "DRAFT").



Hilary Gutman

October 26, 2004